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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,813	01/29/2004	Puwen Zhang	AHPWA1DUSA	5696

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EXAMINER	
BETTON, TIMOTHY E	
ART UNIT	PAPER NUMBER
1617	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,813	ZHANG ET AL.	
	Examiner	Art Unit	
	Timothy E. Betton	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *49 and 50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *49 and 50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' Remarks filed 20 September 2007 have been acknowledged and duly made of record.

The essence of applicants' arguments are drawn to the assertion that Example 133 of the present specification does, in fact, provide adequate detail as to how to sufficiently make the claimed compound in view of claimed invention.

Applicants ' arguments are considered but, however, are not found persuasive.

Again, the last paragraph of the Synthetic methodology fails to adequately disclose how to make the claimed title compound. Granted, the title compound is cited to have been prepared according to procedure B, but there is no definitive explanation of what occurs during procedure B or at least a complete and definitive representation of method steps directed to enabling claimed invention. Also, there is no elucidation in regard to an adequate manner of making the claimed compound from the disclosure cited under Example 133. Instant specification cites that a white solid is obtained but the same specification is absent of any adequate preparation steps and/or explanation directed to making the compound as claimed (Previous office action (09/20/2007), page 4, 2nd paragraph).

Further, whether the skilled artisan is apprised of such methods or procedures is of no consequence to the extent that the applicants' have not properly elucidated this particular step in the process or manner of making as required above.

For the reasons already made of record, the 112, 1st paragraph rejection is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49 and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,509,334. Although the conflicting claims are not identical, they are not patentably distinct from each other because patented claim 1 and all claims dependent therefrom teach the exact core moiety and identical constituent substitutions (See column 65, lines 48-67; column 66, lines 1-67; column 67, lines 1-35). Particularly in patented claim 1, R5 is selected from the group consisting of a trisubstituted ring structure containing the substituents X,Y, Z. Accordingly, within claim 50 of the instant invention R5 is selected from a substituted benzene ring which also contains the substituents X,Y, Z. The two disclosures above are interchangeable and thus the subject matter of instant

claim 49 and 50 are made obvious by the subject matter of claim 1 disclosed in (Zhang et al. 6,509,334 B1).

Claims 49 and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,566,358. Although the conflicting claims are not identical, (i.e., the instant patent teaches methods) they are not patentably distinct from each other because patented claims 1, 7, 10-18, 44 and 45 teach the exact core moiety and identical constituent substitutions (See column 67, lines 59-67; column 68, column 73-75; column 76, lines 1-55; column 77, lines 59-67; column 78-84). Particularly in patented claim 1, R5 is selected from the group consisting of a trisubstituted ring structure containing the substituents X, Y, Z. Accordingly, within claim 50 of the instant invention R5 is selected from a substituted benzene ring which also contains the substituents X, Y, Z. The two disclosures above are interchangeable and thus the subject matter of instant claim 49 and 50 are made obvious by the subject matter of claims 1, 7, 10-18, 44 and 45 are disclosed in (Zhang et al. USPN 6,566,358).

Claims 49 and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,713,478. Although the conflicting claims are not identical, (i.e., the instant patent teaches methods) they are not patentably distinct from each other because patented claims 1, 8, and 45-49 and all claims dependent therefrom teach the exact core moiety and identical constituent substitutions (See columns 67-68, 72, column 77, lines 64-67; column 78-84). Particularly in patented claim 1, R5 is selected from the group consisting of a trisubstituted ring structure containing the substituents X, Y, Z. Accordingly, within claim 50 of the instant invention R5 is selected from a substituted

benzene ring which also contains the substituents X, Y, Z. The two disclosures above are interchangeable and thus the subject matter of instant claim 49 and 50 are made obvious by the subject matter of claim 1 disclosed in (Zhang et al. USPN 6,713,478).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy E. Betton whose telephone number is (571) 272-9922. The examiner can normally be reached on Monday-Friday 8:30a - 5:00p.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TEB

S. Wang

SHENGJUN WANG
PRIMARY EXAMINER